

### REMARKS

Claims 1-27 are pending. Claims 1 and 16 have been amended to clarify the subject matter. No new matter has been added.

The representative of the applicant wishes to thank the Examiner for taking the time to discuss the case on June 4, 2003. The Examiner suggested that amending claims 1 and 16 as indicated above may overcome the cited references.

The representative of the applicant also wishes to thank the Examiner for indicating that claims 7-15 are allowed and that claims 19-27 include allowable subject matter.

In view of the above amendments and the following remarks, the applicant respectfully requests withdrawal of each of the rejections and allowance of the application.

### Claim Rejections 35 USC § 102

Claims 1-6, 16-18 were rejected under 35 U.S.C. § 102(e) as being anticipated by Motoi et al. (US 6,480,016). As discussed below, applicants respectfully disagree.

Amended claim 1 of the present application recites a method that includes:

- generating event signals;
- storing the event signals in a holding circuit;
- producing response signals in a device under test (DUT) in response to the event signals; and
- evaluating the DUT based on a comparison of the response signals from the DUT with the stored event signals received from the holding circuit.**(Emphasis Added)

The Motoi patent fails to disclose the above bolded features for at least the following reasons. FIG. 1 of the Motoi patent shows a tester body 101 that is used to transmit and receive signals to and from a device 103 contained on a test board 102. An *input signal* is read from the first storage 105a via the storage control circuit 106a and is supplied to the device 103. An *output signal* in response to the *input signal* is output from the device 103 and fed to a comparator 107. An *expectation value signal* corresponding to the input signal is output from the second storage 105b and fed to the comparator 107. The *expectation value signal* is a signal having a value that is expected from the device in response to an input signal when the device is operating normally. The comparator 107 compares the *output signal* from the device 103 (the

response from the device) with the *expectation value signal* (the expected response from the device) from the tester body. Although the *input signal* is stored in the first storage 105a and then fed to the device 103, the comparator 107 does not **compare** the *input signal* with the *output signal*. That is, the Motoi patent **compares** the actual response from the device and the expected response, whereas, claim 1 of the present invention recite an apparatus that evaluates the DUT based on "a comparison of the response signals from the DUT with the stored event signals received from the holding circuit." Therefore, claim 1 and dependent claims 5-6 are not anticipated.

Moreover, the Motoi patent fails to teach an apparatus that is configured for "producing response signals in a device under test (DUT) in response to the event signals" as recited in claim 1. Rather, in the Motoi patent, the device produces the *output signal* in response to the *input signal* and not in response to the *expectation value signal*. As mentioned above, the expectation value signal is a predetermined expected value that should be produced from the device in response to an input signal when the device is operating normally. Thus claim 1 is not anticipated by the Motoi patent for at least these additional reasons.

Accordingly, since claim 1 is not anticipated, dependent claims 2-6 are also not anticipated.

Claim 16 has been amended to recite a system that includes a holding circuit for receiving the event signals and trigger signals, and for capturing the event signals, and a measuring device for evaluating the DUT based on a comparison of the response signals from the DUT with the captured event signals from the holding circuit." Claim 16, as well as dependent claims 17 and 18, should be allowable for at least the reasons discussed above.

Consequently, applicant respectfully requests reconsideration and withdrawal of the 35 U.S.C. § 102(e) rejection.